REMARKS

In the Office Action mailed from the United States Patent and Trademark Office on May, 6, 2004, the Examiner rejected claims 1, 2, and 4-28, under 35 U.S.C. 103(a) as being unpatentable over Kondo (JP 200095663A) in view of Talon et al. (Derwent Acc. No. 2000-248448), Moinz (U.S. Pat. No. 5,288,491), and Duffy et al. (U.S. Pat. No. 5,472,699). Accordingly, Applicant respectfully provide the following:

Rejections under 35 U.S.C. 103

An invention is unpatentable under Section 103(a) "if the differences between the subject matter sought to be patented over the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which the subject matter pertains." To establish a *prima facie* case of obviousness, three criteria must be met.

> First there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the references or combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, and not based on applicant's disclosure. *In re Vaeck*, 947 F.2d 488 (Fed. Cir. 1991); M.P.E.P. § 2142.

The combined references fail to produce or suggest each element of the claimed invention. To establish *prima facie* obviousness of a claimed invention, all the claim limitations must be taught or suggested by the prior art. *In re Vaeck*, 947 F.2d 488 (Fed. Cir. 1991); M.P.E.P. § 2142. Applicant respectfully submits that the references cited by the Examiner do not teach or suggest the limitations claimed in the present invention. In particular, Claim 1 of the present invention claims a method for "making and administering a topical cosmetic skin

toner...comprising...combining said processed Morinda citrifolia juice with at least one ingredient selected from a balancing toner ingredient and hydrating toner ingredient ..." Thus, claim 1 as provided herein include the limitation "processed Morinda citrifolia juice." And, none of the references cited by the Examiner, alone or in combination teaches or suggests such limitations. The example composition in Kondo contains the bark extract of the noni plant. Bark is not fruit. The Examiner takes the position that one skilled in the art would assume that different parts of the plant would have the same effects. This position is flawed in several respects. First, from a common sense perspective it would be obvious to even lay observers that one would not expect the same effects from eating a banana and eating bark from a banana tree. Further, from a common sense perspective, one would not expect the same effects from eating the fruit of a banana and the peel from a banana. This common sense approach is confirmed by reasonable scientific minds.

Living organisms are chemical systems. They are made from a distinctive and restricted set of small carbon-based molecules that are essentially the same for every living species. The main categories are sugars, fatty acids, amino acids, and nucleotides. Consequently, on a most basic level noni bark and noni fruit are composed of similar carbon-based molecules. Even though living organism share the same set of carbon-based molecules, diversity among living organisms is virtually unlimited. Diversity exists even though there is a restricted set of molecules because even small changes in molecular form produce significant effects in living organisms. One example of diversity that can exist based on small molecular changes are polysaccharides, which differ only in the type of linkage between the two glucose units, but are chemically distinct. Since the oligosaccharides associated with proteins and lipids may have six or more different kinds of sugar joined in both linear and branched arrangements, the number of

distinct types of oligosaccharides that can be used in cells is extremely large. Simple polysaccharides composed only of glucose residues - principally *glycogen* in animal cells and *starch* in plant cells - are used to store energy for future use. But sugars have functions in addition to the production and storage of energy. Important extracellular structural materials (such as cellulose) are composed of simple polysaccharides, and smaller but more complex chains of sugar molecules are often covalently linked to proteins in *glycoproteins* and to lipids in *glycolipids*. Bark consists primarily of cellulose while the fruit consists mainly of starch. As a consequence of a small molecular difference between starch and cellulose, the fruit but not the bark is digestable by humans. Bark and fruit for the purposes of human applications are essentially different.

It is well documented, and experiments have proven, that different parts of the Indian Mulberry or Morinda citrifolia plant comprise different ingredients. The leaves of Morinda citrifolia contain: alanine, anthraquinones, arginine, ascorbic acid, aspartic acid, calcium, beta-carotene, cysteine, cystine, glycine, glutamic acid, glycosides, histidine, iron, leucine, isoleucine, methionine, niacin, phenylalanine, phosphorus, proline, resins, riboflavin, serine, beta-sitosterol, thiamine, threonine, tryptophan, tyrosine, ursolic acid, and valine. The flowers of Morinda citrifolia contain: acacetin-7-o-beta-d(+)-glucopyranoside, 5,7-dimethyl-apigenin-4'-o-beta-d(+)-galactopyranoside, and 6,8-dimethoxy-3-methylanthraquinone-1-o-beta-rhamnosyl-glucopyranoside. The fruit of Morinda citrifolia contains: the fruit: acetic acid, asperuloside, butanoic acid, benzoic acid, benzyl alcohol, 1-butanol, caprylic acid, decanoic acid, (E)-6-dodeceno-gamma-lactone, (Z,Z,Z)-8,11,14-eicosatrienoic acid, elaidic acid, ethyl decanoate, ethyl hexanoate, ethyl octanoate, ethyl palmitate, (Z)-6-(ethylthiomethyl) benzene, eugenol, glucose, heptanoic acid, 2-heptanone, hexanal, hexanamide, hexanedioic acid, hexanoic acid

(hexoic acid), 1-hexanol, 3-hydroxy-2-butanone, lauric acid, limonene, linoleic acid, 2-methylbutanoic acid, 3-methyl-2-buten-1-ol, 3-methyl-3-buten-1-ol, methyl decanoate, methyl elaidate, methyl hexanoate, methyl 3-methylthio-propanoate, methyl octanoate, methyl oleate, methyl palmitate, 2-methylpropanoic acid, 3-methylthiopropanoic acid, myristic acid, nonanoic acid, octanoic acid (octoic acid), oleic acid, palmitic acid, potassium, scopoletin, undecanoic acid, (Z,Z)-2,5-undecadien-1-ol, and vomifol. The roots of Morinda citrifolia contain: anthraquinones, asperuloside (rubichloric acid), damnacanthal, glycosides, morindadiol, morindine, morindone, mucilaginous matter, nor-damnacanthal, rubiadin, rubiadin monomethyl ether, resins, soranjidiol, sterols, and trihydroxymethyl anthraquinone-monomethyl ether. The root bark of Morinda citrifolia contains: alizarin, chlororubin, glycosides (pentose, hexose), morindadiol, morindanigrine, morindine, morindone, resinous matter, rubiadin monomethyl ether, and soranjidiol. The wood of Morinda citrifolia contains: anthragallol-2,3-dimethylether; from the tissue culture: damnacanthal, lucidin, lucidin-3-primeveroside, and morindone-6beta-primeveroside. The plant Morinda citrifolia contains: alizarin, alizarin-alpha-methyl ether, anthraquinones, asperuloside, hexanoic acid, morindadiol, morindone, morindogenin, octanoic acid, and ursolic acid. See specification pg. 21-22. Consequently, contrary to the Examiner's position, one of ordinary skill in the art would recognize that different ingredients, different parts of plants, often perform different functions and have different effect. Thus, it cannot be said that the ingredients in the bark would inherently provide the same effects as the ingredients form the fruit, because these ingredients are distinctly different. Because fruit and bark are distinctive the example formulation taught in Kondo utilizing ingredients from bark, cannot be said to teach or suggest the same effects as a similar formulation utilizing ingredients from the fruit.

Applicant further submits that Kondo cannot be combined with either Moniz or Duffy to arrive at the claims of the present invention as amended. Moniz relates to methods of processing the noni plant into powder. The method for processing the noni plant into powder includes steps of picking, storing, washing, cleaning, mashing the fruit, and crushing and grinding dried wafers. Moniz does not teach or suggest the application of a cosmetic skin toner comprising processed *Morinda citrifolia* combined with at least one ingredient capable of balancing pH levels in the skin or hydrating the skin. Moreover, one of ordinary skill in the art would not combine Kondo with Moniz to arrive at the claims of the present invention as neither of these references contain a suggestion to do so. A modification to the example formulation in Kondo, with the processed Morinda citrifolia fruit juice of the present invention, would materially alter the composition for its intended purpose. As such, these two references do not render obvious the claims of the present invention.

Applicant further submits that Talon cannot be combined with Kondo for reasons previously stated in regard to Moniz. Talon teaches the use of various fruit juices as invigorating drinks, which regulate natural body functions. One of the characteristics of these fruit juices is an antiseptic quality. Similar to Moniz, Talon does not teach or suggest the application of a cosmetic skin toner comprising processed Morinda citrifolia combined with other ingredients capable of balancing pH levels in the skin or hydrating the skin. Moreover, one of ordinary skill in the art would not combine Kondo with Talon to arrive at the claims of the present invention, and neither of these references contain a suggestion to do so. The entire disclosure of Talon relates to the use of fruit juices for ingestion having systemic effects, but does not suggest the use of fruit juices for topical cosmetic treatment. As such, these references do not render obvious the claims of the present invention.

A *prima facie* case of obviousness may also be rebutted by showing that the art, in any material respect, teaches away from the claimed invention. *In re Geisler*, 116 F.3d 1465, 1471 (Fed. Cir. 1997). In the Office Action the Examiner indicates that Kondo teaches cosmetic composition comprising plant extracts, including Morinda citrifolia, which provide skin whitening, oxygen scavenging and/or antimicrobial effect. Morinda citrifolia is disclosed by Kondo, but Kondo teaches away from using Morinda citrifolia alone. In paragraph 4 Kondo indicates, speaking of Morinda citrifolia and other vegetable extracts generally, that they have a low antibacterial effect, and that the benefit of the Kondo invention includes improved antibacterial effect. Consequently, Kondo is teaching away from the present invention in which Morinda citrifolia is utilized independent of other ingredients added to facial treatments disclosed in Kondo.

Accordingly, Applicant respectfully submits that for at least the reasons provided herein, the references cited by the Examiner, alone or in combination, do not teach or suggest all the claim limitations. And, since the references cited by the Examiner do not teach or suggest each and every limitation of the independent claims, Applicant respectfully submits that the prior art references do not make obvious claims 1, 2, and 4-28 as provided herein. Thus, Applicant respectfully submits that for at least the reasons provided herein, the claim set as provided herein overcomes all rejections made by the Examiner in the Office Action.

CONCLUSION

Applicants submit that the amendments made herein do not add new matter and that the claims are now in condition for allowance. Accordingly, Applicants request favorable reconsideration. If the Examiner has any questions or concerns regarding this communication, the Examiner is invited to call the undersigned.

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Respectfully submitted,

Michael F. Krieger
Attorney for Applicant
Registration No. 35,232

KIRTON & McCONKIE
1800 Eagle Gate Tower
60 East South Temple
Salt Lake City, Utah 84111
Telephone: (801) 321-4814
Facsimile: (801) 321-4893

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